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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,178	11/09/2001	Derrick J. Dimone	F-7905 PCT	4849

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10/03/2002

LERNER AND GREENBERG, P.A.  
POST OFFICE BOX 2480  
HOLLYWOOD, FL 33022-2480

EXAMINER
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BLACKWELL RUDASIL, GWENDOLYN A

ART UNIT	PAPER NUMBER
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1775

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DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/036,178

Applicant(s)

DIMONE, DERRICK J.

Examiner

Gwendolyn A. Blackwell-Rudasill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 1,5 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 1 is objected to because of the following informalities:

The wording of the claim is confusing to the meaning of the claim. It is suggested to replace “defining” in line 1 with “having”. Appropriate correction is required.

2. Claims 5 and 7 are objected to because of the following informalities:

Claims 5 and 7 include the terms “outside” and “inside”, respectively. The use of the words are confusing to the meaning of the claim. It is suggested to replace “outside” with “top surface” and “inside” with “bottom surface”. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

4. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 has a limitation that the lens has a “relatively high refractive index.” Use of the phrase renders that claim indefinite because it is unclear what would constitute a “relatively high refractive index.”

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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*A person shall be entitled to a patent unless –*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

6. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent no. 4,603,065, Mori et al.

Mori et al., disclose a decorative material that is used for an automobile emblem, top mark, molding, or nameplate. The decorative material comprises a transparent substrate, wherein the substrate can be a concave or convex lens, meeting the requirements of claims 1-2, (columns 1-2, lines 36-26). A colored semitransparent film is formed on the substrate, wherein the film can be titanium oxide, which has a high refractive index, meeting the requirements of claims 5-6, (column 2, lines 4-10 and 27-57). The decorative material may be used in a container or frame, (column 3, lines 50-53).

Mori et al., also disclose that the layer formed on the substrate can be a polyester film with a second indicator formed thereon, meeting the requirements of claim 3, (columns 4-5, lines 67-2).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

8. Claims 4 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent no. 4,603,065, Mori et al. as applied to claims 1-3 above, and further in view of United States Patent no. 4,801,479, Fielder et al.

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The limitations of claims 1-3 are disclosed above. Mori et al., does not disclose that the colored film is a vinyl, or means for attaching the decorative material to the automobile.

Fielder et al., disclose a decorative article that is used a covering for an automotive component, (column 4, lines 14-16). The substrate of the article is a vinyl sheet with a lens cap placed over the substrate, (column 3, lines 10-20). The vinyl may be a solid color, pattern, or have indicia printed on it, (Column 4, lines 23-35). The decorative article is adhered to a surface by a coating of adhesive applied to the bottom side of the vinyl sheet.

Although, Mori et al., and Fielder et al., do not specifically disclose that the adhesive should be double-sided tape, it is within the skill of one in the art at the time of invention to substitute double-sided tape for the adhesive so as to more easily remove the decorative article from the automobile without causing damage to the automobile surface.

9. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent no. 4,603,065, Mori et al. as applied to claims 1-2 above, and further in view of United States Patent no. 5,549,940, Noone.

The limitations of claims 1-2 are disclosed above. Mori et al., does not disclose the means for attaching the decorative material to the automobile.

Noone discloses a sports theme kit for outfitting an automobile that includes a signs that can be temporarily affixed to the vehicle through the use of magnets. The signs are made of a flexible magnetic sheet. On vehicles parts that magnets would not adhere, the backing should have an adhesive material, (column 5, lines 28-33).

Because the inventions of Mori et al., and Noone are drawn to articles used to decorate automobiles, wherein the decorative materials are composed of layered material on substrates, it would have been obvious to one skilled in that art at the time of invention to modify the decorative material of Mori et al., with the adhesive means of Noone to obtain a decorative

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material that adheres to the surface of the automobile without permanently damaging the vehicle exterior.

*Conclusion*


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gwendolyn A. Blackwell-Rudasill whose telephone number is (703) 305-9741. The examiner can normally be reached on Monday - Friday; 6:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (703) 308-3822. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Gwendolyn A. Blackwell-Rudasill  
Examiner  
Art Unit 1775

gbr  
September 25, 2002

  
DEBORAH JONES  
SUPERVISORY PATENT EXAMINER